

REMARKS

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application, in light of the following remarks, is respectfully requested.

By the present amendment, Claims 24-28 have been cancelled without prejudice or disclaimer of the subject matter recited therein. No new matter enters by this Amendment.

Applicants have amended the claims herein to conform to the subject matter expressly disclosed in parent Application U.S. Serial No. 09/804,690, as expressly recognized in the outstanding Office Action, page 2. Accordingly, Applicants are entitled to the benefit of the filing date of that application, and antecedent Application No. 09/146,187; 08/977,918, 08/670,274 and 08/585,758 filed January 16, 1996 on the basis of U.S. Patent Application 60/006,856 filed November 16, 1995. Accordingly, claims 29-34 are entitled, based on the analysis set forth at page 2 of the outstanding Office Action, to an effective filing date of certainly no later than June 13, 1996, and, Applicants respectfully submit, as early as November 16, 1995. Applicants specifically note that the disclosures of the prior applications are expressly incorporated by reference in the pending case. See the original specification, page 1, as well as the amendments thereto, including the Preliminary Amendment dated October 29, 2003.

As recognized in the outstanding Office Action, no new matter is introduced by this Amendment. Upon entry of the amendments, claims 29-34 remain the only pending claims in the case.

In the outstanding Office Action, claims drawn to SEQ ID NO:4 stand rejected, on the basis of limitation to the effective filing date of October 29, 2003. Claims 29-34 are entitled to an effective filing date of no later June, 1996, and thus well in advance of the only prior art reference applied, U.S. Patent No. 5,892,016, Brie et al., filed June 23, 1997.

The claim objection and rejections are addressed, below.

OBJECTION OF CLAIM 26

Previously presented claim 26 stands objected to as referencing a nucleic acid sequence. The objection is rendered moot by the amendments set forth herein and above.

DOUBLE PATENTING

Previously presented claims 24-26 stood rejected as substantial duplicates of claim 27. Without commenting on the relationship between the scope of claims 24-26 and 27, Applicants note that this rejection is moot and its withdrawal is respectfully requested, in light of the amendments advanced herein.

REJECTIONS UNDER 35 U.S.C. § 102(b)

Claims 24-27 stood rejected as anticipated by GenBank referencing Accession No. U8213 (dated June 4, 1998). As noted above, the claims herein are entitled to an effective filing date than no later than 1996. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 24-28 stand rejected for anticipation over U.S. Patent No. 5,92,016 Brie et al.

Upon entry of the above amendments, all claims pending are entitled to an effective filing date at least a year in advance of Brie et al., and accordingly, withdrawal of the rejection is respectfully requested.

With respect to pending claims 29-30, the Examiner's attention is respectfully directed to page 14, line 14 - page 15, line 25, for a full discussion of the polypeptide of the claims. In this respect, it is noted that as originally filed, the term "TSG101 polypeptide" refers specifically to the subject matter of claims 29 and 30, that is, a polypeptide comprising the amino acid sequence of residues 11-390 of SEQ ID NO: 4.

Claims 31-34 address the combination of the polypeptide of claims 29 and 30 with an antibody that binds thereto, in particular, a monoclonal antibody (claims 32 and 34). The use of antibodies, complexation of the antibodies with the polypeptide of claim 29, and their utility, is described at page 15, line 26 - page 19, line 27 of the application as originally filed. Applicants appreciate the Examiner's acknowledgment of the early disclosure now claimed.

CONCLUSION

All outstanding objections and rejections of the claim have been met by amendment and the claims are otherwise directed to patentable subject matter. Accordingly, they are in condition for allowance, and an early and favorable action thereon is respectfully requested.

Contact information for undersigned counsel has changed. A Notification of Change of Contact Information is submitted herewith. Should it be helpful in advancing prosecution, the Examiner is invited to contact undersigned counsel by telephone.

Respectfully submitted,

/Steven B. Kelber/
Steven B. Kelber
Reg. No. 30,073
Customer No. 22,506

JAGTIANI + GUTTAG
Democracy Square Business Center
10363-A Democracy Lane
Fairfax, Virginia 22030
(703) 563-2011 (direct)
(703) 591-2664 (main)
(703) 591-5907 (fax)
February 26, 2007